REMARKS

In the aforesaid Office Action, claims 12, 58, 60 and 65 were rejected under 35 USC 112, second paragraph, claims 11, 13-15, 17-19, 21-26, 50, 51, 56-60, and 65-66 were rejected under 35 USC §103(a) as being unpatentable over Evard (U.S. Patent No. 5,242,396) in view of Berenstein et al. (U.S. Patent No. 5,895,378) and further in view of Crowley et al. (U.S. Patent No. 6,004,279), and claims 12, 16, 53 and 64 were rejected under 35 USC §103(a) as being unpatentable over Evard in view of Crowley and further in view of Berenstein et al. and Lee et al. (U.S. Patent No. 6,733,486). Claims 11-19, 21-23, 25, 26, 51, 53, 56-60, 64 and 65 are pending.

Applicants appreciate the courtesies extended by the Examiner in the telephone interview on November 10, 2004, conducted between the Examiner and Applicant's representative Priscilla Morrison. In the telephone interview, Crowley et al. and Berenstein et al. were discussed. Applicants proposed amending claims 11, 19 and 51 to call for a non-annealed distal section, and argued that in Crowley et al. the distal section is annealed, resulting in a structurally different end product. Applicants stated that the Crowley et al. and Berenstein et al. patents disclose different materials which can be annealed to decrease the flexibility thereof. Applicants agreed to clarify in these Remarks that the term "proximal" as used in Applicant's claims follows the convention of referring to end of the device closest to the user, whereas the term "distal" refers to the end of the device furthest from the user.

The Examiner rejected claims 11, 13-15, 17-19, 21-26, 50, 51, 56-60, and 65-66 under 35 USC §103(a) as being unpatentable over Evard in view of Berenstein et al. and further in view of Crowley et al., stating that Evard discloses the invention substantially as claimed but however does not disclose that the proximal section has a first crystallinity and the distal section has a second crystallinity lower than the proximal section first crystallinity such that the proximal section is stiffer, and Berenstein teaches a PVC or polyurethane catheter provided with added flexibility where the catheter is annealed and Crowley further teaches a guidewire wherein the distal portions are annealed progressively to cause the distal portions to be more flexible than the proximal portions.

The Examiner further states in the Response to Arguments section of the Office Action, that Crowley discloses that varying the flexibility by progressively annealing a portion of the guidewire or the entire guidewire (equivalent or comparable to a mandrel), and that progressively annealing the guidewire to vary the flexibility of, for example, the entire guidewire would mean that the proximal section is less flexible than, or has a higher crystallinity than, the distal section.

However, although Crowley does disclose progressively annealing the entire length of the guidewire to vary the flexibility of the guidewire such that the proximal section is less flexible than the distal section, Crowley does not disclose or suggest an annealed proximal section in combination with a non-annealed distal section as required by claims 1, 19, and 51. Specifically, Crowley explicitly discloses that at least the distal tubular portion (i.e., the distal section) is annealed progressively to cause distal portions of the progressively annealed distal tubular portion to be more flexible than proximal

portions thereof (col. 2, lines 6-10), and that the flexibility of the guidewire may be varied by progressively annealing either a portion, e.g., distal tubular portion 24, or the entire length of the guidewire (col. 4, lines 62-65). Thus, in Crowley, annealing increases the flexibility of the annealed portions of the guidewire, in contrast to Applicant's mandrel in which annealing decreases the flexibility of the annealed portions of the mandrel. If Crowely did contemplate that annealing decreased the flexibility of the material of the guidewire, then, in order to provide the guidewire with the proximal tubular portion which is stiffer than the distal tubular portion, Crowley would have disclosed annealing at least the proximal tubular portion (i.e., proximal section) of the guidewire instead of disclosing annealing at least the distal tubular portion.

Similarly, because Berenstein et al. discloses a catheter provided with added flexibility where the catheter is annealed, Berenstein et al. teaches away from a non-annealed distal section as required by the embodiments set forth in Applicant's claims.

Using Applicant's specification, one of skill in the art at the time the invention was made would be able to, without undue experimentation, select nonmetal materials for practicing the claimed invention, which produce a mandrel having an annealed proximal section with a first crystallinity higher than a second crystallinity of a non-annealed distal section.

In addition to other amendments, Applicants have amended claims 11, 19 and 51 to call for the mandrel having a non-annealed distal section, support for which can be found on page 9, line 13.

Applicants have amended claim 51 to delete the requirements that the mandrel distal section have a second crystallinity lower than the first crystallinity of the proximal section, and the said mandrel is uniformly tapered from said proximal section to said distal section, such that said proximal section is stiffer than said distal section.

Applicants wish to note for the Examiner that Applicants mistakenly argued in the July 2004 amendment that claim 51 requires a mandrel formed of polyetheretherketone. Claim 51 does not require that the mandrel is formed of a polyetheretherketone polymeric material, contrary to Applicants' argument presented in the Remarks section of the July 2004 amendment.

In light of the above amendments and remarks, Applicants respectfully request reconsideration and issuance of a timely Notice of Allowance.

Respectfully submitted,

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